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10/715,744

11/18/2003

Gota Asano

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RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GOTA ASANO

Appeal 2009-011335
Application 10/715,744
U.S. Patent Publication 2004/0142237
Technology Center 1700

Decided: September 2, 2009

Before: FRED E. McKELVEY, *Senior Administrative Patent Judge*,
and JAMESON LEE and MICHAEL P. TIERNEY, *Administrative Patent*
Judges.

McKELVEY, *Senior Administrative Patent Judge.*

DECISION ON APPEAL

1 A. Statement of the case

2 Matsushita Electric Industrial Co., Ltd. ("Matsushita"), the real party
3 in interest, seeks review under 35 U.S.C. § 134(a) of a final rejection (mailed
4 10 July 2007).

5 The application was filed on 18 November 2003.

6 Claims 1-8 are in the application.

7 Claims 1-8 stand rejected under 35 U.S.C. § 103 over (1) Yoshinaka,
8 U.S. 6,596,434 (22 July 2003) and (2) prior art described in the Matsushita

1 specification. Yoshinaka is prior art under 35 U.S.C. § 102(e). Matsushita
2 has not attempted to antedate Yoshinaka.

3 Claims 1-6 and 8 stand rejected under 35 U.S.C. § 103 over (1) Han,
4 U.S. Patent 5,837,396 and (2) prior art described in the Matsushita
5 specification. Han is prior art under 35 U.S.C. § 102(b).

6 We have jurisdiction under 35 U.S.C. § 134(a).

7 B. Background

8 Claim 1 on appeal, reproduced from the claims appendix of the
9 Appeal Brief, reads [drawing numbers and bracketed matter added]:

10 An alkaline storage battery comprising:

11 a cylindrical metal case 6, said cylindrical metal case

12 having a bottom [no drawing number];

13 a positive plate 3 having a protrusion 15 projecting out of
14 said positive plate 3;

15 a negative plate 4 having a further protrusion 16
16 projecting out of said negative plate 4;

17 a separator 5 [, *e.g.*, polypropylene tape,] having
18 insulating properties;

19 an upper metal current collector 1 for collecting current
20 from a positive electrode side;

21 a bottom metal current collector 7 for collecting current
22 from a negative electrode side;

23 an electrolyte [specification, page 9:22-23 and
24 page 13:21]; and

1 a sealing plate 2 made of a metal with a hole formed at
2 the center;

3 wherein:

4 an electrode group 22 is formed by spirally winding said
5 positive plate 3 and said negative plate 4 with said separator 5
6 interposed between them [, *i.e.*, plate 3 and plate 4], said
7 protrusion 15 of said positive plate 3 and said protrusion 16 of
8 said negative plate 4 facing mutually opposite directions [, *see*
9 15 and 16,];

10 said electrode group 22 is housed in said metal case 6
11 after joining [, *e.g.*, by welding,] said protrusion of said
12 negative plate 16 with said bottom metal current collector 7,
13 and said bottom metal current collector 7 and said bottom of
14 said metal case 6 are joined;

15 said protrusion of said positive plate 15 is joined with the
16 bottom surface of said upper metal current collector 1;

17 a terminal 13 of said upper metal current collector 1 is
18 disposed through *said hole* in the center of said sealing plate 2,
19 said upper metal current collector 1 and said sealing plate 2 are
20 joined; and

21 a periphery of said sealing plate 2 is hermetically sealed
22 with a gasket 9 at an upper opening of said metal case 6.

23 The Examiner found that Yoshinaka does not explicitly teach a
24 terminal of the upper collector is disposed through a hole in the center of a
25 sealing plate. Examiner's Answer, page 3.

1 To overcome the difference, the Examiner stated the following
2 (Examiner's Answer, pages 3-4):

3 The single sealing structure of Yoshinaka includes a
4 sealing plate portion having an open central area and a terminal
5 attached to and protruding from the plate in an equivalent
6 *manner* as claimed. However, the invention as a whole would
7 have been obvious to one having ordinary skill in the art at the
8 time the invention was made because one of skill would have
9 found the two piece terminal and sealing plate as shown in
10 Figure 1 of the present obvious in view of the single piece
11 terminal and sealing plate as shown in Figures 1-5 of
12 Yoshinaka. The terminal of the upper collector is disposed
13 through a hole in the center of a sealing gasket. The battery cap
14 assembly of the claimed invention and the battery cap assembly
15 of Yoshinaka are obvious variants and one of skill would
16 reasonably expect them to function the same.

17 The Examiner also found that Han does not explicitly teach a terminal
18 of the upper collector is disposed through a hole in the center of a sealing
19 plate. Examiner's Answer, page 5.

20 To overcome the difference, the Examiner stated the following
21 (Examiner's Answer, page 5):

22 The single sealing structure of Han includes a sealing
23 plate portion having an opening central area and terminal
24 attached to and protruding from the plate in an equivalent
25 manner as claimed. However, the invention as a whole would

1 have been obvious to one having ordinary skill in the art at the
2 time the invention was made because one of skill would have
3 found the two piece terminal and sealing plate as shown in
4 Figure 1 of the present invention obvious in view of the single
5 piece terminal and sealing plate as shown in Figure 2 of Han.
6 The battery cap assembly of the claimed invention and the
7 battery cap assembly of Han are obvious variants and one of
8 skill would reasonably expect them to function the same.

9 In addition to the hole in the center of the sealing plate limitation,
10 Matsushita argues that Yoshinaka and Han do not describe a protrusion,
11 electrically connecting the positive plate and the upper metal current
12 collector. Appeal Brief, pages 6 and 10-11.

13 With respect to both rejections, Matsushita maintains that the
14 Examiner's rationale is unsupported by any articulated reasoning with some
15 rational factual underpinning to support the legal conclusion of obviousness,
16 and depends on Matsushita's disclosure. *See, e.g.*, Appeal Brief, page 13.
17 Matsushita also maintains that the Examiner has provided no support or
18 justification that some of the missing features of the Matsushita invention
19 are "obvious variants" of Yoshinaka or Han. *See, e.g.*, Appeal Brief, page 8.

20 C. Discussion

21 Matsushita says the Examiner did not provide any factual background
22 to support what Matsushita characterizes as "conclusory" holdings. The
23 Examiner, on the other hand, identifies (albeit not clearly) elements of
24 Yoshinaka and Han which the Examiner believes support obviousness
25 holdings.

1 We have been unable, based on the record before us, to resolve the
2 appeal on the merits because we are not sure of the Examiner's factual basis.

3 Accordingly, before we enter a decision on the merits, we believe a
4 *remand* is in order to permit the Examiner to further explain the obviousness
5 position and to permit Matsushita to respond to any further explanation by
6 the Examiner.

7 As part of the remand, we request the following.

8 1. The Examiner is requested to verify that (1) we have correctly
9 reproduced claim 1 and that the drawing and (2) other references
10 incorporated therein in brackets are accurate.

11 2. The Examiner is requested to reproduce claim 1 on appeal and
12 insert therein the drawing numbers or other references to the disclosure of
13 Yoshinaka which correspond to the limitations of claim 1 on appeal. To
14 understand what we need, the Examiner may consider the claim with
15 drawing numbers and other references set out in *Ex parte Braeken*,
16 54 USPQ2d 1110 (BPAI 1999).

17 3. The Examiner is requested to reproduce claim 1 on appeal and
18 insert therein the drawing numbers or other references to the disclosure of
19 Han which correspond to the limitations of claim 1 on appeal.

20 4. The Examiner is requested to (1) reproduce the following
21 discussion in the Examiner's Answer, (2) fill in appropriate Yoshinaka
22 drawing numbers or other references in the bracketed spaces and (3) answer
23 the "Why's":

24 The single sealing structure of Yoshinaka includes a
25 sealing plate portion [] having an open central area [] and a

terminal [] attached to and protruding from the plate [] in an equivalent manner [Why? What is meant by equivalent manner?] as claimed. However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one of skill would have found the two-piece terminal [] and sealing plate [] as shown in Figure 1 of the present obvious in view of the single piece terminal [] and sealing plate [] as shown in Figures 1-5 of Yoshinaka. The terminal [] of the upper collector [] is disposed through a hole [] in the center [] of a sealing gasket []. The battery cap assembly [] of the claimed invention and the battery cap assembly [] of Yoshinaka are obvious variants [Why? What is meant by obvious variants?] and one of skill would reasonably expect them to function the same [Why?].

5. The Examiner is requested to (1) reproduce the following discussion in the Examiner's Answer, (2) fill in appropriate Han drawing numbers or other references in the bracketed spaces and (3) answer the "Why's":

The single sealing structure of Han includes a sealing plate portion [] having an opening central area [] and terminal [] attached to and protruding [] from the plate [] in an equivalent manner [Why? What is meant by equivalent manner?] as claimed. However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one of skill would have

1 found the two piece terminal [] and sealing plate [] as shown
2 in Figure 1 of the present invention obvious in view of the
3 single piece terminal [] and sealing plate [] as shown in
4 Figure 2 of Han. The battery cap assembly [] of the claimed
5 invention and the battery cap assembly [] of Han are obvious
6 variants [Why? What is meant by equivalent manner?] and one
7 of skill would reasonably expect them to function the same
8 [Why?].

9 D. Decision

10 Upon consideration of the record and arguments presented, and for the
11 reasons given herein, it is

12 ORDERED that application on appeal is *remanded* to the
13 Examiner for action consistent with the views set out in this opinion.

14 FURTHER ORDERED that the Examiner may respond to the
15 remand with a Supplemental Examiner's Answer.

16 FURTHER ORDERED that, within two months of entry of
17 any Supplemental Examiner's Answer, Matsushita is authorized to file a
18 Supplemental Reply Brief *responding solely to points made* in any
19 Supplemental Examiner Answer.

20 FURTHER ORDERED that nothing in this opinion should be
21 construed as precluding the Examiner from reopening prosecution or
22 allowing claims on appeal.

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Application 10/715,744

1 FURTHER ORDERED that no time period for taking any
2 subsequent action in connection with this appeal may be extended under
3 37 C.F.R. § 1.136(a)(1)(iv) (2008).

REMANDED

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cc (via First Class mail)

RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482